



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,932	12/14/2004	Yasuharu Seki	258218US6PCT	8643
22850	7590	12/05/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
MCADAMS, BRAD				
ART UNIT		PAPER NUMBER		
2456				
NOTIFICATION DATE		DELIVERY MODE		
12/05/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/516,932

Applicant(s)

SEKI ET AL.

Examiner

ROBERT B. MCADAMS

Art Unit

2456

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the amendment filed on September 09, 2008
2. Claims 1-20 are pending.

Response to Arguments

3. Applicant's amendment with respect to **Claim 10** has been fully considered. The 35 U.S.C. 101 rejection of Claim 10 has been withdrawn.
4. Applicant's arguments with respect to **Claims 1-10** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-4, 8-10, and 14-20** are rejected under 35 U.S.C. 102(e) as being anticipated by *McCaleb* (U.S. Patent No. 6,751,794).
7. As to **Claims 1, 3, 8-10, 15, 18 and 20**, *McCaleb* discloses an information processing apparatus (**Server 105, Figure 1**) comprising:

memory means for separately storing functional generation information and application software (**Client Database 125 stores functional generation information and current application software versions of connected clients. Column 3, Lines 59-64**);

managing means for managing first functional generation information that corresponds to the application software stored in said memory means (**Column 3, Lines 59-64**);

obtaining means for obtaining second functional generation information that corresponds to the application software (**Software patches and updates**), wherein the second functional information is registered in an information providing apparatus (**Part Database 120**), wherein the information providing apparatus is remotely located from said information processing apparatus and connected to said information processing apparatus via a network (**Column 4, Lines 2-4**), and wherein said obtaining means obtains said second functional generation information based on said first functional generation information (**Second functional generation information is obtained when first functional generation information is in need of updating. Figure 2**);

comparing and determining means for comparing said first functional generation information and said second functional generation information and for determining which of said first or second functional generation information is a newest functional generation information; and information updating means for, when said comparing and determining means determines that said second functional generation information is newer than said first functional generation information, updating said first functional

generation information stored in said memory means to said newest functional generation information, such that said memory means contains said second functional generation information **(Server 105 access Client Database 125 and compares second functional generation information with the first functional generation information. If second generation information is newest, Client Database 125 is updated with the said information. Figure 2; Column 4, Lines 19-44).**

As to **Claims 2, 14 and 17**, *McCaleb* further discloses a means for determining whether a predetermined time has passed on a basis of said first functional generation information, wherein when said passage determining means determines that said predetermined time has passed, said obtaining means obtains said functional generation information registered in said information providing apparatus via said network **(Update is performed on a periodic basis, such as every 24 hours. Column 4, Lines 11-18).**

As to **Claims 4, 16 and 19**, *McCaleb* further discloses wherein when said function determining means determines that said software does not have the function corresponding to said second functional generation information, said software updating means updates the software stored in said memory using the software corresponding to said second functional generation information **(Server 105's Client Database 125 is compared against the Part Database 120, which can be embodied in a single information processing apparatus Server 105, updating the Client System 110 with the newest functional generation information. Paragraph bridging Column 3 and 4)**

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 5-7 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over *McCaleb* (U.S. Patent No. 6,751,794) in view of *Xian* (U.S. Patent No. 6,327,584).

10. As to **Claims 5 and 13**, *McCaleb* discloses comparing said first functional generation information and said second functional generation information with each other and determining newest functional generation information as discussed in Claim 1.

However, *McCaleb* does not expressly disclose comparing a third functional generation information from a recording medium.

Xian, in the same field of endeavor, teaches a medium determining means for determining whether a recording medium is loaded; and reading means for reading third functional generation information as functional generation of software recorded on said recording medium when said medium determining means determines that said recording medium is loaded and said information updating means updates said first functional generation information to said newest functional generation information; and said software updating means updates the software stored in said memory using software corresponding to said newest functional generation information. **(Update**

information (third functional generation) is loaded from the CD-ROM (medium) and used to update the original file (first functional generation) Column 13, Lines 30-42);

At the time of invention, it would have been obvious to a person of ordinary skill in the art to compare the first and second functional generation information as taught by *McCaleb* with the third functional generation information as taught by *Xian* to determine the newest functional generation information. The motivation would have been to provide another medium for updated software versions.

As to **Claim 6**, *McCaleb-Xian* teaches when said obtaining means does not obtain said second functional generation information via said network, said comparing and determining means compares said first functional generation information and said third functional generation information with each other, and determines said newest functional generation information **(Current revision installed on computer and the revision on the CD-ROM (first and third functional generation information) are compared and the newest revision (functional generation information) is saved to the computer. Column 13, Lines 30-42)**. The motivation is the same as Claim 5.

As to **Claim 7**, *McCaleb-Xian* teaches when said comparing and determining process determines that said second functional generation information and said third functional generation information are identical with each other, said information updating means updates said first functional generation information to said third functional generation information; and said software updating means updates the software stored in said memory using software corresponding to said third functional generation

information (**Revision from the network and the revision on the CD-ROM (second and third functional generation information) are compared and the newest revision (functional generation information) is saved to the computer. Column 13, Lines 30-42.** The motivation is the same as Claim 5.

11. **Claims 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over *McCaleb* (U.S. Patent No. 6,751,794) in view of *Eller* (U.S. Patent No. 5,889,860).

As to **Claim 11**, *McCaleb* discloses the information processing apparatus as discussed in Claim 1.

However, *McCaleb* does not expressly disclose wherein said functional generation information is a combination of cryptographic keys, functions, and protocols.

Eller, in the same field of endeavor, teaches using cryptographic keys, functions, and protocols such that said functional generation information is shared among a plurality of application software located in said memory areas (**Paragraph bridging Column 4 and 5**).

At the time of invention, it would have been obvious to one of ordinary skill in the art to combine the information processing apparatus as taught by *McCaleb* with the cryptographic system as taught by *Eller*. The motivation would have been to provide security.

As to **Claim 12**, *Eller-McCaleb* teach wherein said information processing apparatus is a personal computer (**Client 14, Figure 1; Column 4, Lines 40-64**), wherein said information providing apparatus is a server configured to provide said

personal computer a music content distribution service (**Server 12, Figure 1; Column 4, Lines 30-39**);

wherein said application software receives a copyrighted material from said music content distribution service (**Column 5, Lines 3-13**); and

wherein said functional generation information (**license/decryption key**) enables said application software to receive and use said copyrighted material (**Column 5, Lines 3-13**). In addition, the same motivation is used as in Claim 11.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT B. MCADAMS whose telephone number is (571)270-3309. The examiner can normally be reached on Monday-Thursday 6:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. B. M./
Examiner, Art Unit 2456

/Bunjob Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2456